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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,902	02/25/2005	Kazuhiro Yagishita	CU-4101 RJS	9193

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EXAMINER

GOLOBOY, JAMES C

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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06/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/525,902	Applicant(s) YAGISHITA, KAZUHIRO	
	Examiner James Goloboy	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 5, 7-10, 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 7-10, 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's amendment filed 4/30/08 fails to overcome the rejections set forth in the office action mailed 2/4/08. These rejections are maintained below. Newly added claim 16 is also rejected below.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/30/08 has been entered.

Claim Objections

3. Claim 16 is objected to because of the following informality: In line 2 of the claim, "each" should be "earth". The claim has been considered in this manner in the rejection set forth below. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. Claims 1, 5, 7, 9-10, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robson in view of Emert and Shanklin.

The rationale for the rejections of claims 1, 5, 7, and 9-10 is adequately set forth in paragraph 2 of the office action mailed 2/4/08, which is incorporated here by reference. Amended claims 1 and 10 incorporate the subject matter of previous claims 3-4 and 6.

In paragraphs 84-88 Robson discloses that calcium salicylate or a mixture of calcium and magnesium salicylates are preferred detergents, meeting the limitations of newly added claim 16. In paragraph 83 Robson discloses that the metal can also be an alkali metal, also meeting the limitations of claim 16.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robson in view of Emert and Shanklin as applied to claims 1, 5, 7, and 9-10 above, and further in view of Curtis.

The rationale for this rejection is adequately set forth in paragraph 3 of the office action mailed 2/4/08, which is incorporated here by reference.

Response to Arguments

6. Applicant's arguments filed 4/30 have been fully considered but they are not persuasive.

Applicant argues that Emert and Shanklin are not combinable with Robson because the references both include a metal dithiophosphate, while the composition of Robson is preferably phosphorus-free, and the claimed compositions contain "substantially no metal salts of dithiophosphoric acid". This argument fails to account

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for the fact that Robson teaches (in paragraph 8, for example), that the compositions attain satisfactory anti-wear performance without the addition of dithiophosphates. One of ordinary skill in the art, while still looking to Emert and Shanklin for the identities and concentrations of suitable dispersants, antioxidants, and borate esters for use in engine oils, would not have considered metal dithiophosphates to be a required component.

Applicant also asserts that the references do not teach a metal ratio of 3 or less. This limitation was previously present in claim 4 (now cancelled) and was addressed in the prior office actions. Robson discloses detergents with a TBN in the range of 15 to 600, which will clearly lead to a range of metal ratios overlapping or falling within this claimed range. Applicant has not presented any argument or evidence disputing this position.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is (571)272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JCG

/Glenn A Caldarola/
Acting SPE of Art Unit 1797